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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,133	09/25/2001	William Stevens Taber JR.	20162-000310US	1723
20350	7590	05/19/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			BORISOV, IGOR N	
		ART UNIT	PAPER NUMBER	
		3629		

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/964,133	TABER, WILLIAM STEVENS	
	Examiner Igor Borissov	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 February 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-23 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claim Rejections under 35 USC § 112 has been withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yablonowski et al. (US 6,535,859) in view of “American Consumer hunts for an acquisition target” (Document).

Yablonowski et al. teach a method and system for maintaining lighting systems and for monitoring energy consumption of the lighting systems, comprising:

As per claim 1, auditing by implementing entity, comprising an engineering firm, a contractor, a wholesale fixture company, and a lighting service company, energy saving equipment at multiple end user sites (column 6, lines 24-30); providing and deploying by said implementing entity said energy efficient equipment at no cost to said end users (column 7, lines 9-11; column 8, lines 26-27); measuring by said implementing entity of said saved energy at said sites using a method of measurement agreed upon by said end users and said implementing agency (column 7, lines 25-26, 42-63).

Yablonowski et al. do not specifically teach selling by said implementing entity of said saved energy to said end users at a price that is less than the price of energy purchased from an energy generating company.

Document teaches estimating by implementing entity of energy saved after installing energy efficient equipment, and selling saved energy back to end users at a guaranteed discount (page 29, lines 23-32, 56-58; page 31, lines 40-46).

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yablonowski et al. to include selling by said implementing entity said saved energy to end users at a price that is less than the price of energy purchased, as disclosed in Document, because it would stimulate end users to replace the old equipment with more energy efficient equipment.

As per claim 2, Yablonowski et al. teach said method and system, wherein said deployment at said multiple end user sites is performed in a coordinated manner (column 6, line 54 – column 7, line 41).

As per claim 3, see claim 1.

As per claims 4-5, see claim 1.

As per claim 6, Yablonowski et al. teach all the limitations of claim 6, except that auditing is performed by an auditor specializing in evaluating the potential energy saving for a selected type of said energy saving equipment rather than a generalist energy auditor.

Official notice is taken that it is old and well known that auditing is performed by an auditor specializing in his task rather than a person having general knowledge of the art.

Therefor, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Yablonowski et al. to include that auditing is performed by an auditor specializing in evaluating the potential energy saving for a selected type of said energy saving equipment rather than a generalist energy auditor, because it would allow to minimize possible mistakes in auditing, thereby minimizing potential financial losses.

As per claims 7-9 and 12, Yablonowski et al. teach said method and system, wherein actual cost, rather than estimated cost, of said energy saving equipment is utilized to project financial feasibility for said deployment by said implementing entity (column 6, lines 24 – column 7, line 26; column 7, lines 42-63).

As per claim 10, Yablonowski et al. teach said method and system, further comprising methods to reduce financial risk to said implementing entity (column 6, lines 24-29, 54-56).

As per claim 11, Yablonowski et al. teach said method and system, wherein said procurement is performed in a volume sufficient to increase profit of said sale of saved energy to a preselected amount (column 6, lines 54-56).

As per claims 16-17, Yablonowski et al. teach said method and system, wherein

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said implementing entity receives an incentive from an energy utility company to undertake said procurement, said deployment and combinations thereof (column 1, lines 25-28).

As per claims 18-21, see claim 1.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yablonowski et al. and Document in view of Adams et al. (US 6,154,730).

As per claims 13 and 14, Yablonowski et al. and Document teach all the limitations of claims 13 and 14, except that mode of financing is credit enhancement.

Adams et al. teach a method and system for facility-based financing, wherein credit financing is employed (column 4, lines 9-12).

It would have been an obvious matter of design choice to modify Yablonowski et al. and Document to include that mode of financing is credit enhancement, as disclosed in Adams et al., because said mode of financing is well known, and without indicating in the specification the advantage of said credit enhancement, it appears that use of said credit enhancement mode of financing is a matter of business choice.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yablonowski et al. and Document in view of King (US 6,148,293).

As per claim 15, Yablonowski et al. and Document teach all the limitations of claim 15, except that mode of financing includes tax-exempt, floating rate.

King teaches a method and system for creating a financial instrument and administering an adjustable rate loan system, wherein tax-exempt, floating rate is employed (column 6, lines 11-40; column 17, lines 16-26).

It would have been an obvious matter of design choice to modify Yablonowski et al. and Document to include that mode of financing includes tax-exempt, floating rate, as disclosed in King, because said mode of financing is well known, and without indicating in the specification the advantage of said tax-exempt, floating rate, it appears that use of said tax-exempt, floating rate mode of financing is a matter of business choice.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yablonowski et al. and Document in view of Wallman (US 6,360,210).

As per claim 22, Yablonowski et al. and Document teach all the limitations of claim 22, except that risk of inadequate energy saving equipment performance is undertaken by a party other than said implementing entity or said end user.

Wallman teaches a method and system for enabling smaller investors to manage risk in a self-managed portfolio of assets, wherein a risk for a given project (portfolio) can be transferred to a third party (column 5, line 64 – column 6, line 8).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yablonowski et al. and Document to include that risk of inadequate energy saving equipment performance is undertaken by a third party, as disclosed in Wallman, because it would stimulate end users to replace the old equipment with more energy efficient equipment.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yablonowski et al. and Document in view of Johnson (US 6,169,979).

As per claim 23, Yablonowski et al. and Document teach all the limitations of claim 23, except using environmental rebates to stimulate end users to replace the old equipment with more energy efficient equipment.

Johnson teaches a computer-assisted method and system for utilities, wherein environmental rebates are employed (column 5, lines 1-21).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yablonowski et al. and Document to include using environmental rebates to stimulate end users to replace the old equipment with more energy efficient equipment, as disclosed in Johnson, because it would provide the financial incentives for the end users to reduce pollution and contamination of the environment.

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Response to Arguments

Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 305-7687 [Official communications; including After Final
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

[Signature]

[Signature]
JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600